

REMARKS

Claims 1-42 are currently **cancelled** in the application. Claims 43-80 are currently **added**. The new claims find support in the specification and are discussed in the relevant sections below, and are also fully supported by the claims as originally filed. No new matter is added.

Priority

The Examiner states that Applicants' claim for priority of FR 99/03925, filed March 29, 1999, can not be made because the foreign application was filed more than twelve months before the filing date of the present application. Applicants submit a proper priority claim was made with the present application when filed on September 26, 2001, which states that the present application is a continuation of PCT/IB00/00370, filed March 29, 2000, which claims priority to FR 99/03925. Applicants have amended the specification to include, as the first paragraph, a statement of the proper priority claim for the present invention. Applicants submit that, however, the filing date of PCT/IB00/00370 in the filing receipt is not accurate, a request for correction of the filing receipt is enclosed. Applicants submit further that a certified copy of the FR 99/03925 application has been requested and will be submitted to the U.S. PTO upon receipt.

Specification

The abstract is objected to because it contains legal phraselology. Applicants have amended the abstract to comply with MPEP § 608 as required by the Examiner, thereby obviating the objection. The amendments to the abstract are supported by the original abstract and specification, e.g., on page 5, lines 8-14; page 6, line 33 to page 7, line 6; page 8, lines 6-12; and page 8, line 18 to page 9, line 1.

The specification is objected to because of its citations of trademarks. Applicants have amended the specification to comply with the requirements of MPEP §608.01(v), thereby obviating this objection.

Finally, the Office Action notes that the Figures contain Arabic numerals, whereas the

figures are identified using Roman numerals in the Brief Description section of the specification. Applicants have replaced the Roman numerals with the corresponding Arabic numerals in the specification, thereby eliminating the inconsistency to the Brief Description.

Claims

The Examiner has objected to the claims on several grounds. Claims 4, 5, 21-26, and 40-42 were objected to because the sequence identifier was listed as “No.” instead of “NO:”. Applicants have amended the claims to obviate this objection.

Claims 4, 16, 21, and 30 were objected to because they contain editor’s markings. Applicants submit that the file copy of the claims which Applicants possess contain no such markings, however, the submission of new claims 43-80 should obviate this objection.

Claim 31 was objected to as being in improper dependent form, and claim 24 was objected to because the term “sequence” was misspelled. Finally, claims 23 and 40 are objected to as being substantial duplicates. Applicants submit that the newly added claims should obviate these objections.

Rejection of Claims 1-4, 6-17, 19-21, 27, and 29-39 Under 35 U.S.C. §112, First Paragraph

Written Description

The Examiner has rejected claims 1-4, 6-17, 19-21, 27, and 29-39 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the promoter recited in the claims encompasses a genus of any and all chimeric promoters wherein the vascular expression promoter region of any plant promoter comprising said vascular expression promoter region is replaced by the green tissue expression promoter region from any plant promoter comprising said green tissue expression promoter region. Applicants have submitted new claims 43-80 which should obviate the Examiner’s rejection for the reasons set out below.

Applicants submit that the newly submitted claims are limited to a promoter derived from first plant promoter originating from a Commelina Yellow Mottle Virus comprising a plant

vascular expression promoter region which is replaced with a nucleic acid sequence derived from a second plant promoter originating from a Cassava Vein Mosaic Virus comprising a plant green tissue expression promoter region. Thus, the present claims are not drawn to “any” plant promoter or “any” promoter comprising a green tissue promoter expression region. As noted by the Examiner, the specification provides a written description of such promoter constructs, and thus the current claims should overcome the Examiner’s rejection.

The Examiner also asserts that the claims lack written description in the recitation of promoters “derived from” naturally occurring plant promoters. As the Examiner notes, the phrase “derived from” is defined in the specification (“deriving directly or indirectly from the sequence to which it refers, for example, by substitution, deletion, addition, mutation, fragmentation, and/or synthesis of one or more nucleotides”), and that the written description requirement for such a phrase may be satisfied by the disclosure of a representative number of species of such “derived from” promoters. The Examiner asserts that the specification only teaches a single species of a chimeric promoter falling under the claims of the invention. Applicants respectfully disagree.

As noted above, the instant claims are limited to chimeric promoters (vectors, transgenic plants, expression cassettes, and methods) which originates from a Commelina Yellow Mottle Virus wherein the plant vascular expression promoter region is replaced with a plant green tissue expression promoter region derived from Cassava Vein Mosaic Virus. Applicants respectfully submit that the Examiner is incorrect that the specification only provides a single species of the claimed invention. To the contrary, Example 2, beginning on page 21, discloses 12 different species of chimeric promoters which are included in the claimed genus, and 19 different species of binary vectors which are also encompassed in the claimed genus. Thus, the specification discloses a representative number of species of the claimed invention to satisfy the written description requirement. Applicants accordingly submit that one of skill in the art would have recognized that Applicants were in possession of the claimed invention. Applicants therefore request that the rejection be reconsidered and withdrawn.

Enablement

The Examiner has also rejected the claims under 35 U.S.C. §112, first paragraph for lack of enablement. The Examiner asserts that the specification does not provide enablement for any and all chimeric promoters wherein the vascular expression promoter region of any plant promoter comprising said vascular expression promoter region is replaced by the green tissue expression promoter region from any plant promoter comprising said green tissue expression promoter region. Applicants respectfully disagree with the Examiner.

New claims have been added herein to recite a promoter derived from first plant promoter originating from a Commelina Yellow Mottle Virus comprising a plant vascular expression promoter region which is replaced with a nucleic acid sequence derived from a second plant promoter originating from a Cassava Vein Mosaic Virus comprising a plant green tissue expression promoter region. The Examiner states that the specification is enabled for a chimeric promoter wherein the vascular expression promoter from the CoYMV intergenic region promoter is replaced with the green tissue promoter region from the CsVMV intergenic region promoter. Applicants submit that the newly submitted claims are so limited, and are thus enabled by the present specification. The specification provides 12 different species of chimeric promoters which are included in the claimed invention, and 19 different species of binary vectors which are also encompassed in the claimed invention. The specification teaches at pages 21-47 how to construct the claimed chimeric promoters and expression vectors. Pages 48-60 of the specification teaches methods for determining the expression of the claimed chimeric promoter, and provides working examples demonstrating the expression of the claimed promoters. Thus, the specification teaches how to make the claimed invention, how to use the claimed promoters to drive expression in plants, and how to test whether a promoter which would fall under the claims of the invention would be operable in a plant. Accordingly, Applicants submit that the specification provides sufficient teachings to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. Applicants thus request that the rejection be reconsidered and withdrawn.

Rejection of Claims 4, 11-13, 17-18, and 21-42 Under 35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 4, 11-13, 17-18, and 21-42 under 35 U.S.C. §112, second paragraph as being indefinite. Applicants submit that the new claims filed herewith obviate each of the Examiner's rejections.

The Examiner has rejected the claims for the use of the indefinite pronoun "it". Applicants submit herewith new claims without this term, thereby obviating the rejection.

The Examiner has rejected claim 8 as indefinite in the recitation of "said promoter of viral origin," as there are two distinct promoters of viral origin in claim 7, from which claim 8 depends. The newly filed claims no longer contain this ambiguity with respect to promoters of viral origin. Applicants request that this rejection be withdrawn.

The Examiner has rejected claims 27-29 and 42, and claims 30-32, which depend from claim 29, for the recitation of "isolated promoter or promoter nucleic acid sequence," since the terms are apparently synonymous given the definition on page 2 of the specification. The newly added claims submitted herewith do not contain these alternative terms. Therefore, Applicants request that the rejection be reconsidered and withdrawn.

The Examiner has rejected claims 15 and 16 as being indefinite for lack of antecedent basis in the recitation of "said as1 like, as1, and as2 boxes". Applicants believe that the newly added claims submitted herewith obviate this rejection, and request that the rejection be withdrawn.

The Examiner has rejected claim 22 as being indefinite in being directed to an expression cassette of claim 19 wherein the first or second promoter from which the promoter of the expression cassette is constructed is selected from the group consisting of SEQ ID NO: 3-7 and 19-25. Applicants submit that claim 22, now cancelled, corresponds to newly added claim 65 which is clear as to the nature of the expression cassette claimed. Applicants accordingly request that the rejection be withdrawn.

The Examiner has rejected claims 26 and 42 as being indefinite in the recitation of "said sequence". Applicants submit that claims 26 and 42 have been cancelled and no analogous claims are currently pending. Applicants accordingly request that the rejection be reconsidered and withdrawn.

The Examiner has rejected claim 41 as being indefinite in the recitation of "said first or second sequence" for lack of antecedent basis. Applicants submit that claim 41 has been cancelled, and replaced by newly added claim 67. Applicants submit further that new claim 67 is clear and definite and does not contain any recitation which lacks antecedent basis.

Rejection of Claim 42 Under 35 U.S.C. §102(b)

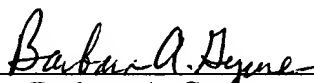
The Examiner has rejected claim 42 under 35 U.S.C. §102(b) as being anticipated by Verdaguer et al. (WO 97/48819). Claim 42 has been cancelled, and no analogous claim is currently pending. Thus, Applicants submit that Verdaguer et al. is no longer prior art to the claimed invention and request that the rejection be reconsidered and withdrawn.

Conclusion

Applicant submits that all claims are allowable as written and respectfully request early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney for Applicant.

Respectfully submitted,

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